

REMARKS/ARGUMENT

As previously discussed in the Amendment and Request for Reconsideration filed on April 25, 2007 for the above-identified application (hereinafter “April 25, 2007 Amendment”), claims 1-10, 19-35, 38-76 and 112-114 and new claims 115-116 are pending in the present application, with claims 1, 48, 74 and 76 amended herein and claims 11-18 and 36-37 having been withdrawn and claims 77-111 having been canceled in Amendment mail dated November 2, 2006.

Notice of Non-Compliant Amendment (37 C.F.R. 1.121)

A Notice of Non-Compliant Amendment (37 C.F.R. 1.121) (hereinafter “the Notice”), was issued alleging that the April 25, 2007 Amendment “does not describe how newly added claims 115-116 overcome the prior art of record”. The April 25, 2007 Amendment was in response to the non-final Office Action mail dated January 25, 2007.

In a telephone conference on August 7, 2007, Primary Examiner Lalita M. Hamilton clarified that the basis for the Notice was 37 C.F.R. § 1.111(b), not 37 C.F.R. § 1.121 or § 1.4 as stated in the Notice. As explained in the conference, new claims 115-116 depend from independent claim 1 (*see also* April 25, 2007 Amendment, p. 13). Claim 1 was rejected in the January 25, 2007 Office Action under 35 U.S.C. § 102(e) as being anticipated by Hoyos U.S. Patent Publication No. 2002-0082993 (“Hoyos”). A discussion of how independent claim 1 overcomes the cited prior art Hoyos reference was provided in the April 25, 2007 Amendment and is repeated below in the present reply.

For at least the reasons stated for independent claim 1 in the April 25, 2007 Amendment, new claims 115-116 overcome the cited prior art Hoyos reference. Hoyos nowhere discloses or suggests each and every element of independent claim 1, and thus, does not and cannot disclose or suggest each and every element of new claims 115 and 116. Thus, new claims 115 and 116 should be in a condition for allowance.

REMARKS/ARGUMENT FROM APRIL 25, 2007 AMENDMENT

Claims 1-10, 19-35, 38-76 and 112-114 and new claims 115-116 are pending in the present application, with claims 1, 48, 74 and 76 amended herein and claims 11-18 and 36-37 having been withdrawn and claims 77-111 having been canceled in Amendment mail dated November 2, 2006.

The preamble to claims 1, 74 and 76 was amended to correct a minor inconsistency and accurately reflect that the payee has a bank account at a payee bank. Amendments were also made to claims 48, 74 and 76 to correct minor antecedent basis issues.

Anticipation Rejection of Claims 1-10, 19, 21-35, 38-63 and 67-76 Based on Hoyos

In the January 25, 2007 non-final Office Action, claims 1-10, 19, 21-35, 38-63 and 67-76 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hoyos U.S. Patent Publication No. 2002-0082993 (Hoyos).

Hoyos teaches a system having an ATM that allows a customer to pay bills (*see, e.g.*, Hoyos, ¶ [0066]) in which the ATM is connected to a server that interfaces with a clearing house and various service providers (*see, e.g.*, ¶ [0070]). Hoyos' teaching of a system with an ATM also includes prompting an ATM user numerous times (*see, e.g.*, ¶¶ [0066], [0073], [0074], [0075], [0077], [0078], [0084], [0087]-[0089], [0092], [0100], [0101], and [0105]) for such input as payment options, payment amount, transfer execution, and payment coupons. Hoyos' system does not, however, teach or suggest several limitations of the pending claims, and thus, differs from the claimed invention as described below.

Independent Claim 1

Claim 1 of the pending application recites *inter alia* an automated payment system comprising a first computer at a payor bank communicatively coupled to a document scanning system and adapted to receive an image of a check and an image of an invoice. Claim 1 further recites a second computer at a payee bank communicatively coupled to the first computer and

adapted to receive the image of the check and the image of the invoice from the first computer. In contrast to the claimed invention, Hoyos does not disclose or suggest an automated payment system with a first computer at a payor bank communicatively coupled to a second computer at a payee bank. Rather, Hoyos' discloses a system in which transactions are conducted through an ATM server with separate interfaces to a clearing house and to service providers (*see* Hoyos, FIG. 2) where the clearing house directs an electronic transfer from a customer's account to a vendor's account (*see* ¶ [0101]). Furthermore, Hoyos does not disclose a first computer at a payor bank and a second computer at a payee bank adapted to receive an image of a check and an image of an invoice. Hoyos generally discloses a system in which an ATM includes features of image acquisition and delivery of data to any central processing station (*see* ¶ [0034]). Hoyos also refers to making payments by check at an ATM (*see* ¶ [0066]-[0067]), but the disclosure only states determining an amount and account information with no reference to a computer at a payee bank receiving images of a check and images of an invoice from a computer at a payor bank. In short, Hoyos does not disclose a system with a first computer at a payor bank communicatively coupled to a second computer at a payee bank in which the second computer is adapted to receive an image of a check and an image of an invoice from the first computer, as recited in claim 1.

Applicant submits that Hoyos does not, and cannot, anticipate independent claim 1, and its dependent claims 2-10, 19, 21-35, and 38-47, because Hoyos nowhere discloses or suggests each and every element of the claimed invention. Since all the elements of claim 1 cannot be found in Hoyos, a *prima facie* case of anticipation has not been established. Furthermore, it also follows that a *prima facie* case of anticipation has not been established for any of the respective dependent claims.

Independent Claim 48

Claim 48 of the pending application recites *inter alia* a method comprising transmitting the image of a check and the image of an invoice to a payor financial institution and a payee financial institution. In contrast to the claimed invention, Hoyos does not disclose transmitting the image of a check and the image of an invoice to payor and payee financial institutions.

Rather, Hoyos' generally discloses a system in which an ATM includes features of image acquisition and delivery of data to any central processing station (*see* ¶ [0034]). Hoyos also refers to making payments by check at an ATM (*see* ¶ [0066]-[0067]), but the disclosure only states determining an amount and account information with no reference to transmitting the image of a check and the image of an invoice to a payor financial institution and a payee financial institution. In short, Hoyos does not disclose a system for transmitting images of a check and an invoice to payor and payee financial institutions, as recited in claim 48.

Applicant submits that Hoyos does not, and cannot, anticipate independent claim 48, and its dependent claims 49-63 and 67-73, because Hoyos nowhere discloses or suggests each and every element of the claimed invention. Since all the elements of claim 48 cannot be found in Hoyos, a *prima facie* case of anticipation has not been established. Furthermore, it also follows that a *prima facie* case of anticipation has not been established for any of the respective dependent claims.

Independent Claim 74

Claim 74 of the pending application recites *inter alia* an automated payment system comprising a first computer at a payor bank communicatively coupled to a document scanning system and adapted to receive an image of a check or invoice and a second computer at a payee bank that is communicatively coupled to the first computer and adapted to receive the image of the check or the invoice. In contrast to the claimed invention, Hoyos does not disclose or suggest an automated payment system with a first computer at a payor bank communicatively coupled to a second computer at a payee bank. Rather, Hoyos' discloses a system in which transactions are conducted through an ATM server with separate interfaces to a clearing house and to service providers (*see* Hoyos, FIG. 2) where the clearing house directs an electronic transfer from a customer's account to a vendor's account (*see* ¶ [0101]). Furthermore, Hoyos does not disclose a first computer at a payor bank and a second computer at a payee bank adapted to receive an image of a check or an invoice. Rather, Hoyos generally discloses a system in which an ATM includes features of image acquisition and delivery of data to any central processing station (*see* ¶ [0034]). Hoyos also refers to making payments by check at an

ATM (*see* ¶ [0066]-[0067]), but the disclosure only states determining an amount and account information with no reference to a second computer at a payee bank adapted to receive an image of a check or an invoice from a first computer at a payor bank or a document scanning system. In short, Hoyos does not disclose a system with a computer at a payor bank communicatively coupled to a computer at a payee bank in which the computers are adapted to receive an image of a check or an image of an invoice, as recited in claim 74.

Applicant submits that Hoyos does not, and cannot, anticipate independent claim 74 because Hoyos nowhere discloses or suggests each and every element of the claimed invention. Since all the elements of claim 74 cannot be found in Hoyos, a *prima facie* case of anticipation has not been established.

Independent Claim 75

Claim 75 of the pending application recites *inter alia* a method comprising transmitting the image of a check and the image of an invoice to a payor financial institution and the image of a check to a payee financial institution. In contrast to the claimed invention, Hoyos does not disclose transmitting the images of a check to payor and payee financial institutions and images of an invoice to a payor financial institution. Rather, Hoyos' generally discloses a system in which an ATM includes features of image acquisition and delivery of data to any central processing station (*see* ¶ [0034]). Hoyos also refers to making payments by check at an ATM (*see* ¶ [0066]-[0067]), but the disclosure only states determining an amount and account information with no reference to transmitting the image of a check and the image of an invoice to a payor financial institution and transmitting the image of a check to a payee financial institution. In short, Hoyos does not disclose a system for transmitting the image of a check and the image of an invoice to a payor financial institution and the image of a check to a payee financial institution, as recited in claim 75.

Applicant submits that Hoyos does not, and cannot, anticipate independent claim 75 because Hoyos nowhere discloses or suggests each and every element of the claimed invention. Since all the elements of claim 75 cannot be found in Hoyos, a *prima facie* case of anticipation

has not been established.

Independent Claim 76

Claim 76 of the pending application recites *inter alia* an automated payment system comprising a first computer at a payor bank communicatively coupled to a plurality of document scanning systems and adapted to receive an image of a check or invoice and a second computer at a payee bank communicatively coupled to the first computer and adapted to receive the image of the check or the invoice. In contrast to the claimed invention, Hoyos does not disclose or suggest an automated payment system with a first computer at a payor bank communicatively coupled to a second computer at a payee bank. Rather, Hoyos' discloses a system in which transactions are conducted through an ATM server with separate interfaces to a clearing house and to service providers (*see* Hoyos, FIG. 2) where the clearing house directs an electronic transfer from a customer's account to a vendor's account (*see* ¶ [0101]). Furthermore, Hoyos does not disclose a first computer at a payor bank and a second computer at a payee bank adapted to receive an image of a check or an invoice. Hoyos generally discloses a system in which an ATM includes features of image acquisition and delivery of data to any central processing station (*see* ¶ [0034]). Hoyos also refers to making payments by check at an ATM (*see* ¶ [0066]-[0067]), but the disclosure only states determining an amount and account information with no reference to a first computer at a payor bank and a second computer at a payee bank that are communicatively coupled and adapted to receive an image of a check or an invoice, as recited in claim 76.

Applicant submits that Hoyos does not, and cannot, anticipate independent claim 76 because Hoyos nowhere discloses or suggests each and every element of the claimed invention. Since all the elements of claim 76 cannot be found in Hoyos, a *prima facie* case of anticipation has not been established.

Dependent Claims 2-10, 19, 21-35, 38-47, 49-63 and 67-73

In the January 25, 2007 non-final Office Action, a one-sentence anticipation rejection of claims 2-10, 19, 21-35, 38-47, 49-63 and 67-73 was made based on Hoyos. The rejected claims

depend (that is, add further limitation) from independent claims 1 and 48. The unsupported rejection is based on a generic cite to earlier referenced sections from Hoyos without providing any specific elements from the 57 rejected claims. As such, the anticipation rejection of claims 2-10, 19, 21-35, 38-47, 49-63 and 67-73 is improper, not only for the reasons stated for the respective independent claims, but also since no showing of a *prima facie* case of anticipation has been established. For example, claims 4-6 recite a personal computer adapted to receive an image of a check and an image of an invoice from the first computer; claim 10 recites an imprinter adapted to imprint an authorization agreement; claims 41-45 recite a plurality of output bins or first and second output bins; and claim 46 recites a stacking wheel. Hoyos does not disclose these elements of the claimed invention.

For the reasons stated above for independent claims 1 and 48 and for the reasons cited herein, the applicant submits that Hoyos does not, and cannot, anticipate dependent claims 2-10, 19, 21-35, 38-47, 49-63 and 67-73 because Hoyos nowhere discloses or suggests each and every element of the claimed invention nor was any such showing made in the January 25, 2007 Office Action. Since all the elements of claims 2-10, 19, 21-35, 38-47, 49-63, and 67-73 have not been established nor can they be found in Hoyos, a *prima facie* case of anticipation has not been made.

Obviousness Rejection of Claims 20, 64-66 and 112-114 Based on Hoyos in View of Norris

In the January 25, 2007 non-final Office Action, claims 20, 64-66, and 112-114 were rejected under 35 U.S.C. § 103(a) as being obvious based on Hoyos in view of Norris U.S. Patent No. 6,105,007 (Norris).

Claims 20, 64-66, and 112-114 depend (that is, add further limitation) from independent claims 1 and 48 and independent claims 74, 75 and 76, respectively. As discussed above in the anticipation section, since all the elements of independent claims 1, 48, 74, 75 and 76 cannot be found in Hoyos, a *prima facie* case of anticipation has not been established. Furthermore, the rejection of claims 20, 64-66, and 112-114 based on Hoyos in view of Norris does not overcome

the deficiencies discussed for the anticipation rejections of claims 1, 48, 74, 75 and 76. For example, the Office Action cites to Norris column 4, lines 5-15, which discloses the printing of a check by a printer housed in a kiosk. Norris does not disclose a printer operable to print a substitute check from an image of a check as recited in the claimed invention. In this regard, neither of Hoyos and Norris, either alone or in combination, discloses or suggests the claimed invention.

Since all the elements of claims 20, 64-66, and 112-114 cannot be found in Hoyos in further view of Norris, a *prima facie* case of obviousness has not been established.

CONCLUSION

Applicant submits that claims 1-10, 19-35, 38-76, and 112-114 and new claims 115-116 are in condition for allowance and action toward that is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (312) 425-8552.

It is believed that no additional fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from the Nixon Peabody Deposit Account No. 50-4181, Order No. 247171-000290USPT.

Dated: August 7, 2007

Respectfully submitted,

/Peter J. Prommer/
Peter J. Prommer
Registration No.: 54,743
NIXON PEABODY LLP
161 North Clark Street, 48th Floor
Chicago, Illinois 60601
(312) 425-3900

Attorney For Applicant